

**REMARKS**  
**§102 rejections**

In the 6 February 2007 Office Action claims 64 – 69, 71 – 73, 75 – 80, 82 – 84, 86 – 91 and 93 - 95 are rejected under §102 as being anticipated by "How to sort out premium drivers of post deal value" by Daniel Bielinski (hereinafter, Bielinski). The Examiner has cited the Bielinski document as a reference. The Assignee respectfully traverses the rejections for anticipation in two ways. First, by noting that the claim rejections fail under both standards of the APA. Second, by noting that the Office Action has failed to establish a prima facie case of anticipation for the rejected claims. More specifically, the Office Action fails to establish a prima facie case of anticipation in as many as three separate ways for every rejected claim.

The first way in which the 6 February 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to describe every element of the claim. MPEP 2131 notes that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The second way in which the 6 February 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to provide the same level of detail that is present in the claim. MPEP 2131 notes that anticipation requires that:

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The third way in which the 6 February 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the Office Action does not describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in the Bielinski document. MPEP 2112 notes that:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the

applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The Assignee respectfully submits that the rejection of independent claim 64 can be traversed by noting that Bielinski: is missing elements contained in claim 64, provides insufficient detail regarding elements of claim 64 and that any alleged inherency of elements of claim 64 in the Bielinski document has not been explained. Elements of claim 64 not explicitly or inherently described in the Bielinski document include: segments of value. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 64 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 64 has not been established. Claims 64 - 69 and 71 - 73 are directly dependent on claim 64 so the traversal of the claim 64 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

The Assignee respectfully submits that the rejection of independent claim 75 can be traversed by noting that Bielinski: is missing elements contained in claim 75, provides insufficient detail regarding elements of claim 75 and that any alleged inherency of elements of claim 75 in the Bielinski document has not been explained. Elements of claim 75 not explicitly or inherently described in the Bielinski document include: segments of value. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 75 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 75 has not been established. Claims 76 - 80 and 82 - 84 are directly dependent on claim 75 so the traversal of the claim 75 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

The Assignee respectfully submits that the rejection of independent claim 86 can be traversed by noting that Bielinski: is missing elements contained in claim 86, provides insufficient detail regarding elements of claim 86 and that any alleged inherency of

elements of claim 86 in the Bielinski document has not been explained. Elements of claim 86 not explicitly or inherently described in the Bielinski document include: segments of value. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. The Assignee notes that there are still other ways in which the §102 rejection of claim 86 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 86 has not been established. Claims 87 – 91 and 93 – 95 are directly dependent on claim 86 so the traversal of the claim 86 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

Summarizing the above, the 6 February 2007 Office Action the Assignee respectfully submits that the Examiner has failed to produce the evidence required to establish a prima facie case of anticipation for a single claim. The complete failure to identify anticipation at the claim level clearly illustrates the fact that the cited reference is not even remotely similar to the claimed invention. As noted in MPEP 2112, anticipation requires that a substantial identity be established. Taken together, these failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. The Assignee notes that there are still other ways in which the §102 anticipation rejections in the 6 February 2007 Office Action for claims 64 – 69, 71 – 73, 75 – 80, 82 – 84, 86 – 91 and 93 – 95 can be traversed.

### **§103 rejections**

In the 6 February 2007 Office Action, claims 70, 74, 81, 85, 92 and 96 are rejected under §103 as being unpatentable over Bielinski in view of Machine Learning Research – Four Current Directions by Thomas Diettrich (hereinafter Diettrich). The Assignee respectfully traverses the §103 rejections of claims 70, 74, 81, 85, 92 and 96 in two ways. First, by noting that the rejections fail under both standards of the APA. Second, by noting that the cited combination of documents fails to establish a prima facie case of obviousness in a number of ways, including:

1. teaching away from the theoretical combination proposed by the Examiner,
2. requiring a change in the principle of operation of each cited invention in order to enable replication of claimed functions, and
3. failing to meet any of the criteria for establishing a prima facie case of obviousness.

The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 6 February 2007 Office Action for claims 70, 74, 81, 85, 92 and 96 can be traversed. For example, the cited combination does not make the invention as a whole obvious and is not enabling.

The first way the cited combination of documents fails to establish a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96 is by citing a combination of documents that teaches away from the proposed combination. *MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination."* The cited combination of documents teaches away from the proposed combination in a number of ways, including:

1. Incompatible methods. Bielinski teaches analyzing data in order to quantify the historical relationship between financial performance and the level of spending for different sub-components of value. Diettrich teaches analyzing historical data with an ensemble of models in order to learn rules. The Assignee is not aware of any way in which the ensemble of models can be combined with the Bielinski model to produce anything useful. Furthermore, the Examiner has not explained how the theoretical combination would be made or how it would function.

The Assignee notes that there are still other ways in which the two references teach away from the proposed theoretical combination. Furthermore, the Assignee finds it ironic that

the Examiner complained about a large number of reference documents, then provided a 40 page document that:

1. is largely irrelevant,
2. is relevant in part only because it teaches away from claimed methods,
3. includes information that is well known to those of average skill in the art, and/or
4. includes information that has already disclosed in a number of previously provided reference documents.

The second way that the cited combination of documents fails to establish a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96 is that the proposed combination of documents would change the principle of operation of the Bielinski and Dietrich methods. *MPEP 2143.01 provides that when "the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)".*

Changes in operating principles required by the cited combination include:

1. Change in the historical analysis principle explicitly required by Bielinski. As noted previously, Bielinski teaches analyzing data in order to quantify the historical relationship between financial performance and the level of spending for different sub-components of value (Bielinski refers to them as value drivers). In the 6 February 2007 Office Action the Examiner is attempting to combine the teachings of the Bielinski method with the teachings of Dietrich in order to replicate a forward looking model that can be used for forecasting and managing financial performance. As such, the proposed modification would destroy one of the operating principles of the Bielinski method – strict reliance on historical performance. As a result, the teachings of the references are not sufficient to render the claims prima facie obvious.

The Assignee notes that there are still other operating principles which need to be changed in order to support the cited combination.

The third way the cited combination of documents fails to establish a prima facie case of obviousness required to sustain the rejections of claim 70, 74, 81, 85, 92 and 96 is that it fails to meet any of the criteria for establishing a prima facie case of obviousness. MPEP 2142 provides that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As detailed below, the 6 February 2007 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96.

1. The 6 February 2007 Office Action fails to meet the first criteria for establishing a prima facie cause of obviousness for claims 70, 74, 81, 85, 92 and 96 because the Office Action does not identify any realistic motivation for making the theoretical combination contained in the Office Action. It is well established that "teachings of references can be combined only if there is some suggestion or incentive to do so" quoting *ACS Hosp. Sys., Inc. v Montefiore Hosp.*, 732 F.2d 1572, 1577 221 U.S.P.Q 929,933 (Fed. Cir. 1984). The Examiner has cited value driver selection as a possible motivation for the theoretical combination; however, the Assignee notes that the value drivers referenced by Bielinski are fixed so there is no need for an analysis to select them. Furthermore, the claimed invention examines all the components and sub components of value (which Bielinski calls "value drivers") so selecting different sub-components of value for analysis teaches away from the claimed method.
2. The 6 February 2007 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96 because it does not cite a combination of teachings that has a reasonable expectation of success. As noted previously, the two documents teach fundamentally different approaches to data analysis and the Examiner has not identified a mechanism for reconciling these incompatible approaches in order to produce anything useful.
3. The 6 February 2007 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more of the limitations for every independent claim. The prior discussion related to §102 rejections already listed elements that are missing from each of the independent claims, 64, 75 and 86, that the rejected dependent claims 70, 74, 81, 85, 92 and 96 respectively, rely on. Other missing limitations include: elements of value and components of value.

Far from establishing a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96, the cited combination of references in the 6 February 2007 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and

useful results is new, novel and non-obvious. It does this by calling for a combination of references when there is a motivation not to combine them, by citing a combination of references that does not appear to have a reasonable chance for success and by relying on a combination of references that fails to teach or suggest almost all of the claim limitations.

### **Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended were to correct inadvertent clerical errors.



#### Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

#### Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,



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